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| APPLICATION NO.   | FILING DATE  | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |              |                 |  |  |
|---|--------------|----------------------|--|------------------|--------------|-----------------|--|--|
| 09/632,139  | 08/03/2000   | Ryoichi Imanaka      | MAT-3720US4  | 2101             |              |                 |  |  |
| 7590  | 12/15/2005   |                      | <table border="1"><tr><td>EXAMINER</td></tr><tr><td>BROWN, RUEBEN M</td></tr></table>                    |                  | EXAMINER     | BROWN, RUEBEN M |  |  |
| EXAMINER  |              |                      |  |                  |              |                 |  |  |
| BROWN, RUEBEN M   |              |                      |  |                  |              |                 |  |  |
| Ratner & Prestia<br>P O Box 980<br>Valley Forge, PA 19482 |              |                      | <table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>2611</td><td></td></tr></table> | ART UNIT         | PAPER NUMBER | 2611            |  |  |
| ART UNIT  | PAPER NUMBER |                      |  |                  |              |                 |  |  |
| 2611  |              |                      |  |                  |              |                 |  |  |

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/632,139 | <b>Applicant(s)</b><br>IMANAKA, RYOICHI |  |
|                              | <b>Examiner</b><br>Reuben M. Brown   | <b>Art Unit</b><br>2611                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14,15,17-19,21,22 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14,15,17-19,21,22 and 37-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 08/503604.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 14-15, 17-19 & 21-22 have been considered but are moot in view of the new ground(s) of rejection. Examiner notes that the currently amended feature of; 'effected responsive to detection of an identifier in said medium', is substantially the same as the amendment filed 9/24/03, which reads; 'is effected responsive to detection of an identifier that identifies the medium'. In response to the earlier amendment, the Yoo reference was applied, and therefore is likewise applied in response of the current amendment.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 14-15, 17-19, 21-22 & 37-40 & 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton, (U.S. Pat # 4,945,563) in view of Yoo, (U.S. Pat # 5,497,240).

Considering amended claim 14, the claimed computer information system comprising a provider for providing information to a recipient reads on the central office connected to the cable TV or satellite distribution system, see col. 3, lines 61-68. The additional claimed feature of the 'provider charging a different amount to the recipient depending upon whether the information is recorded' reads on the disclosure of Horton that subscriber's may preview a movie free-of-charge, may be charged a certain amount for viewing the movie and a different amount is charged when the movie is ordered for recording, col. 2, lines 25-67; col. 3, lines 40-55 & col. 4, lines 21-34.

Horton does not teach the amended claimed feature of the recording information in the medium being 'effected responsive to the detection of an identifier in the medium'. Nevertheless, Yoo discloses a subscriber video library system that detects the identity of a recording medium before recording, in order to determine whether a new or old tape has been inserted, (col. 4, lines 28-67 & Fig. 2). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Horton with the technique of effecting a recording a recording responsive to the ID of the recording medium being identified, at least for the desirable advantage of determining if a newly inserted tape is a new one or an old, as taught by Yoo, col. 5, lines 1-13.

As for the claimed computer information system, Yoo discloses that the user system includes a microcomputer 90, (Fig. 1; col. 3, lines 35-67).

Considering claim 15, the claimed transmission means for transmitting information to the recipient is met by the CATV/satellite distribution system, discussed in Horton, (col. 3, lines 61-64).

Considering claim 17, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected.

Considering claim 18, the claimed elements of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected. As for the different feature of receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45).

Considering claim 19, the claimed elements of a computer information system that corresponds with subject matter mentioned above in the rejection of claim 14, are likewise rejected. As for the different feature of a recipient for receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45).

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Considering claim 21, the claimed signal transmitted from a recipient of information to a provider of information, such that the signal indicates whether the information is recorded in a medium, is met by the disclosure in Horton that the decoder 28 could provide billing information to the store and hold circuit 46, which is then transmitted to the proper billing authority, see col. 3, lines 35-60. The instant billing information shows which viewing mode was selected by the subscriber, and thus what charges are being billed.

Considering claim 22, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 21, and are likewise rejected.

Considering claim 37, the claimed elements of an information receiver, correspond substantially with the subject matter mentioned above in the rejection of claims 14 & 19, and are likewise rejected.

Considering claims 38-39, the monitor 42 of Horton meets the claimed terminal device to output the information, see Fig. 1 & col. 3, lines 52-55; col. 4, lines 20-26.

Considering claim 40, the claimed 'informing designating unit designate the information', is broad enough to the read on the decoder 28, that decodes the coded information and provides an indication to the user of the various modes of the particular decoded program, see Horton, col. 3, lines 35-42.

Considering claim 42, the information processed and viewed in Horton is audio/video information.

4 Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horton & Yoo as applied to claim 37 above, and further in view of Lindman, (U.S. Pat # 4,882,752).

Considering claim 41, even though both Horton & Yoo discuss the use of identifiers, the references do not discuss the additionally claimed feature of, 'an informing unit to inform that the identifier is wrong, if the identifier is not registered'. Nevertheless, Lindman (col. 9, lines 10-47; col. 10, lines 62-68 thru col. 11, lines 1-15 & Fig. 5) provides a teaching of informing a user of terminal 12a or 12b, when the personal ID code entered is not registered for authorization to use the system. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combination of Horton & Yoo with the feature of informing a user when their personal ID is not authorized to access the system, at least for the desirable purpose of warning the operator that further communication is not authorized, as taught by Lindman, col. 9, lines 40-47.

*Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



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**Any response to this action should be mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**or faxed to:**

(571) 273-8300, (for formal communications intended for entry)

**Or:**


(571) 273-7290 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown

  
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